

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

TRADEMARK EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant:	Laureate Learning Systems, Inc.	:	BEFORE THE
Trademark:	Laureate	:	TRADEMARK TRIAL
Serial No:	76/226.904	:	AND
Attorney:	Peter B. Kunin	:	APPEAL BOARD
Address:	DOWNNS, RACHLIN & MARTIN, : PLLC. 199 Burlington Street P.O. Box 190 Burlington, VT 05402-0190	:	ON APPEAL

The applicant has appealed from the examining attorney's final refusal to register the mark "LAUREATE" under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the ground that the mark is confusingly similar to the mark "LAUREATE" in U.S. Registration No. 1,508,958. The final office action in this case was issued on March 5, 2002. On September 4, 2002, Applicant submitted a Request for Reconsideration, which the examining attorney denied, and a Notice of Appeal.

On October 31, 2002, Applicant filed a request for a three month suspension in order to obtain a consent agreement with the owner of the cited registration in this case. Such was granted by the Trademark Trial and Appeal Board (Board) on November 14, 2002. Thereafter, the applicant requested and the Board granted two more three-month suspensions, until August 14, 2003. A consent agreement presumably not having been obtained, the applicant then filed its appeal brief on August 18, 2003. Action on this case was again suspended, however, when the undersigned examining attorney went on maternity leave and another examiner took over handling of this case. On February 20, 2004, that examiner issued an office action, maintaining the final office action of March 5, 2002. The applicant was provided an opportunity to submit a supplemental brief, but did not do so. On June 22, 2004, the application file was forwarded to the undersigned examining attorney, who has resumed handling of the case and now issues her brief.

FACTS

The applicant appeals from the examining attorney's final refusal to register "LAUREATE" for "Educational software for children and adults with diagnosed disabilities, consisting of children diagnosed with mental retardation, hearing impairments (including deafness), speech or language impairments, visual impairments (including blindness), serious emotional disturbance, orthopedic impairments, autism, or traumatic brain injury and adults diagnosed with developmental disabilities, aphasia, or closed head trauma; namely interactive applications software providing instruction, through direct intervention, in the fields of language, cognition, auditory processing, and reading."

Registration was refused under Trademark Act Section 2(d), 15 U.S.C. 1052(d), because the applicant's mark is confusingly similar to the mark in U.S. Registration No. 1,508,958, "LAUREATE," for "Educational books containing reference materials, supplementary materials, and discourse on the nature of learning and on the instruction of others with learning problems" and "Educational services, namely, providing specialized instruction to others in the fields of remedial reading, writing, and mathematics, and study strategies, through the operation of schools; educational consulting services." No other issues remain.

ARGUMENT

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

The examining attorney must resolve any doubt as to the issue of likelihood of confusion in favor of the registrant and against the applicant who has a legal duty to select a mark, which is totally dissimilar to trademarks already being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979).

Similarity of the Marks

The marks in this case are confusingly similar because they are identical. The applicant does not contend otherwise, nor could it.

If the marks of the respective parties are identical, as here, the relationship between the goods or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *Amcors, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981); TMEP §1207.01(a).

Close Relationship of the Goods and Services

The applicant's goods, "Educational software for children and adults with diagnosed disabilities...; namely interactive applications software providing instruction, through direct intervention, in the fields of language, cognition, auditory processing, and reading," are closely related to the registrant's goods and services, which are "Educational books containing reference materials, supplementary materials, and discourse on the nature of learning and on the instruction of others with learning problems" and "Educational services, namely, providing specialized instruction to others in the fields of remedial reading, writing, and mathematics, and study strategies, through the operation of schools; educational consulting services." The goods and services of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). The goods and services in this case clearly share such a relationship.

The reason that they share this relationship is simple: as shown by the applicant's own website, in addition to other evidence, the goods and services are used together and are marketed in the same trade channels. Evidence attached to the office action of February 20, 2004, consists of pages from the applicant's website. These pages demonstrate that the applicant's software is used in schools; the registrant's services include the operation of schools. Students and their teachers could be sitting in the registrant's LAUREATE school, using the applicant's LAUREATE software. The applicant's website also describes its provision of monographs on the same subject as the registrant's education books, namely educational theories and research. As noted in the February 2004 office action, educators could easily come across both the applicant's monographs and the registrant's books on the same shelf of a library or book store.

Most striking, however, are the statements on the applicant's website that pertain to the software

packages it offers for people in the Headstart program and for remedial reading. At the end of the "Frequently Asked Questions / Questions from Educators" section of the applicant's website, it states, "We offer packages customized for: Birth to Three, Preschool Essential Language, *HeadStart*, Title I and *Remedial* Reading, English as a Second Language, Autism/PDD, and Visual Impairments" (emphasis added)." Much of the applicant's arguments in its various responses has focused on the distinction it alleges exists between remedial education and education for those with learning disabilities. The applicant has argued that its goods are for those with learning disabilities, as opposed to remedial education, which is the field of use of the registrant's goods and services. Not only does the evidence attached to the final office action refute this statement by showing that such products and services often originate from the same sources, the applicant itself admits on its website that it offers its goods in the field of remedial education, the same field as the registrant's goods and services.

Even without this evidence, the record shows that the goods and services are closely related. The wording of the parties' respective identifications alone demonstrates this relationship in that they encompass each other. Both, as written, identify educational materials and services, which are broad enough to include the other. A determination of whether there is a likelihood of confusion is made solely on the basis of the goods and/or services identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999). If the application and cited registration describe the goods and/or services broadly and there are no or few limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods and/or services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.L.*, 24 USPQ2d 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639 (TTAB 1981); TMEP §1207.01(a)(iii).

In addition to these reasons, evidence attached to the final office action shows that the goods and services, despite existing in different forms, nonetheless are closely related. The examining attorney recognizes that the applicant's goods consist of interactive software whereas the registrant's goods and services consist of printed books and services. In many fields, particularly education, this difference is not probative. Attached to the final office action are numerous trademark registrations as well as articles from the Nexis computer database, which show that educational software, printed books and educational services, including the operation of schools and conducting of classes, often originate from the same sources. A quick perusal of the Internet shows that it has become common for entities to produce materials, particularly educational materials, in various forms, such as software, printed books and manuals (not only computer instruction manuals). The applicant argues that its goods in the form

of software are distinguishable from the registrant's books and services; the evidence shows otherwise. The applicant's argument is not persuasive.

The applicant also argues that there is no likelihood of confusion because its consumers are sophisticated and will be able to distinguish its goods from the registrant's goods and services. This argument carries little weight. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

The applicant further argues that the marks here are weak and that, therefore, the registrant's mark should not be protected. To support its claim, the applicant has provided trademark registrations and other examples of third party use of "LAUREATE." This evidence is not persuasive. It consists of only eight other "LAUREATE" marks, six of which are registered. Only two of the registrations cover goods or services related to those in this case (U.S. Registration Nos. 2356146 and 2352697) and they are owned by the same registrant. The remainder of the registrations cover goods and services that are not related to those in this case. U.S. Registration No. 1763417 is for medical and healthcare services. U.S. Registration Nos. 2367752 and 2298176 are for student loan processing and are both owned by Sallie Mae, Inc. Although these registrations cover services for students, their primary focus is not educational. Finally, U.S. Registration No. 232142 is for books about knots, which is clearly not related to the goods and services at issue here. The remaining marks are also not probative; there are only two of them, they are not registered and one involves services related to installation of healthcare information systems. In the field at issue – education – "LAUREATE" is not weak or diluted.

The applicant further argues that the term "LAUREATE" has a general meaning that bestows a laudatory impression to anything to which it refers. The applicant attached several trademark registrations for the mark "LAUREATE" and argues that such shows the term has a laudatory impression when used with all types of goods and services. This argument has little merit. "LAUREATE" does not have the meaning the applicant posits. Moreover, while the registrations submitted by the applicant show that the mark is used by others, these registrations are all on the Principal Register and none contain a disclaimer or acquired distinctiveness claim as to "LAUREATE." Such shows that "LAUREATE" has not been held to be or used as a laudatory term. To the contrary, it is used as an arbitrary and distinctive trademark. When used to represent the applicant's goods, educational software, the term "LAUREATE" does not function as a laudatory expression and is not descriptive of the applicant's software goods. Assuming *arguendo* that applicant has shown that the cited mark is "weak," such marks are still entitled to protection against

registration by a subsequent user of the same or similar mark for the same or closely related goods or services. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976) and cases cited therein.

Finally, the applicant argues that there has been no actual confusion. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990), and cases cited therein. See also *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984), wherein the Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and registrant has no chance to be heard (at least in the absence of a consent agreement, which applicant has not submitted in this case).
Id. at 1026-1027.

CONCLUSION

The marks in this case are identical. Ample evidence -- including the applicant's own website -- demonstrates that the applicant's goods are closely related to the registrant's goods and services. As a result, a likelihood of confusion exists between these marks, and the refusal to register the applicant's mark under Trademark Act Section 2(d), because it is confusingly similar to the mark in Registration No. 1,508,958, should be affirmed.

Respectfully submitted,

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NOTICE: TRADEMARK OPERATION RELOCATING OCTOBER AND NOVEMBER 2004

The Trademark Operation is relocating to Alexandria, Virginia, in October and November 2004. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Applicants, registration owners, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at www.uspto.gov.